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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,246	12/06/2001	Robert Sixto JR.	SYN-064C	5866
24131	7590	11/26/2003	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			PANTUCK, BRADFORD C	
			ART UNIT	PAPER NUMBER
			3731	
			DATE MAILED: 11/26/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/010,246

Applicant(s)

SIXTO ET AL.

Examiner

Bradford C Pantuck

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on September 8<sup>th</sup>, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-16, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 17, and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/06/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election without traverse of Claims 1-10, 17, and 18 in Paper No. 6 is acknowledged. All of the claims have to do with a clip. The nonelected claims (surgical clip with a barb: Fig. 18) describe a clip with a barb. The elected claims describe a clip with a retainer with a length of  $\pi$  times the distance between the arms. The two inventions are clearly two different species. The only potentially novel features of the independent claims are the aforementioned aspects. The material they have in common is well known and generic.

***Claim Rejections - 35 USC § 112***

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant says that the retainer "has a length of *at least* approximately  $\pi$  times the distance between the arms..." It is unclear whether the "at least" is further limiting the word "approximately" or if Applicant is saying that the retainer's length can be any amount greater than  $3.1415 \times$  (the distance between the arms).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 5-10, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,851,359 to Wilson. Wilson discloses a clip with a first arm (10a), a second arm (10b), and a bridge (10c) connecting the two arms forming a U-shaped structure. Wilson's clip has a flexible, deformable retainer (11) [Column 2, lines 10-17]. The retainer (11) has a length of approximately  $\pi$  times the distance between the two arms when the arms are parallel. Using a ruler to measure the relative dimensions, the distance between the two arms is 9.5 mm, and the length (longitudinally) of the retainer is 1.85 mm. Two times is considered to be "at least approximately" 3.1415 times.
4. Regarding Claims 5, 6, 8, and 9, Wilson discloses a retainer (11), which is decouplable from the arms (10 & 10b) [Column 3, lines 34-40]. The fitting, as shown in Figure 7, is a friction fit: friction (among other forces) prevents the head (10e) of the arm (10b) from disengaging.
5. Regarding Claim 7, Wilson discloses the invention as claimed. The deformable retainer (11) can be thought of as two separate retainers, each of which is extending from the respective arms (10a and 10b). The retainers are of equal length, and each has a sharp tip, as shown in Fig. 7. Shown in Fig. 6 is the fitting on each retainer, and the sharp edges adjacent components 11d and 11c.
6. Regarding Claim 10, Wilson discloses a clip with two arms. Each arm includes an end portion defining a slot (10f & 10d) [Column 2, lines 60-65]. The retainers

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(11- two sides) have a proximal portion, which has a friction fit with each respective slot [Figures 3 and 7].

7. Claims 1, 2, 4, and 5, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,575,802 to McQuilkin et al. McQuilkin discloses a surgical clip with a first arm (12), a second arm (142), and a U-shaped bridge (16) connecting them [see Fig. 1; Column 1, lines 55-67]. McQuilkin discloses a deformable retainer (deformable particularly at hinge 144) extending from arm (142). The deformable retainer (140/144/126/128) has a length greater than  $\pi$  times the distance between the arms when the arms are substantially parallel [as shown in Fig. 2]. The distance between the arms is 2 mm [Column 3, line 11], and the length of the retainer portion (140), as measured from the hinge in an arcing trajectory to the edge (152) is significantly greater than 3 times the distance between the parallel arms. Examiner estimates that the length of the retainer portion (140) is 11 mm.
8. Regarding Claim 2, McQuilkin discloses a surgical clip with a retainer having a thickness smaller than the thickness of the first arm. The thickness of the retainer is measured at hinge (144). The first arm has a thickness of 3 mm and the hinge portion of the retainer has a thickness of 1mm [Column 3, lines 10 and 13; Fig. 2].
9. Regarding Claim 4, McQuilkin discloses a retainer with a sharp tip. Retainer portion (140) has a sharp tip at tooth (150) and retainer portion (126/128) has a sharp tip at tooth (126).

10. Regarding Claim 5, McQuilkin discloses a retainer that is decouplable from one of the arms. If one were to disassemble hinge (16), then one would sever one arm from the other, decoupling the first arm (12) from the retainer (140).
11. Claims 1, 5, and 6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,246,495 to Alessi, et al. Regarding Claim 1, Alessi discloses a clip capable of use in surgery with two arms (11, 12) and a U-shaped bridge (10) between them. There is a deformable retainer (16/21) extending between the arms that has a length of greater than 3 times the distance between the arms, as shown in Fig. 3. The retainer includes a deformable spring member (21) [Column 2, lines 24-34].
12. Regarding Claims 5 and 6, Alessi's retainer (17/21) is decouplable from one of the arms. Arm (11) is attached to the tubular member (16) via a lug (19) in a slot (20) [Column 2, lines 15-20]. The aforementioned lug is merely a nut screwed on (involving friction) to arm (31).
13. Claims 17 and 18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,430,997 to DiGiovanni et al. DiGiovanni discloses a multiple clip applier for applying clips as disclosed by the applicant. DiGiovanni's clips (11) each have a first arm, a second arm, and a U-shaped bridge connecting them. Each clip has a deformable ("deflectable") retainer at its end [Column 4, lines 46-54]. Each retainer has a length of at least  $\pi$  times the distance between the arms when the arms are substantially parallel, as shown in Figure 5A.

As is observable from Fig. 5A, the average distance between the two arms is much less than the length of the retainer, as measured perpendicular from the longitudinal axis of the clip [see Attachment #1].

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,657,519 to Smith

U.S. Patent No. 4,390,019 to LeVeen et al.

U.S. Patent No. 4,988,355 to Leveen et al.

U.S. Patent No. 4,346,869 to MacNeill

U.S. Patent No. 4,044,429 to Wagner

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
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4,430,997

Retainer colored  
yellow.

